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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/758,001

01/09/2001

Christopher C. Burger

CPL1538-196

8540

8698

7590

11/25/2003

STANDLEY LAW GROUP LLP
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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/758,001

Applicant(s)

BURGER ET AL.

Examin r

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communicati n appears on the c ver sheet with th c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stucky et al (US 6,344,268) in view of Deaner et al (US 5,486,553). It appears that nothing in Applicants' specification discloses or suggests the inclusion of additional materials in the foamed polymer layer affect the novel or basic characteristics of Applicants' invention. Therefore, Applicant bares the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; *In re Delajarte* 143 USPQ 256) in order to overcome the finding of obviousness. Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in establishing that non-recited components materially change the characteristics of Applicants' invention.

Stucky teaches a composite material for use in door and window sills and sashes comprising a foamed polymer layer and a synthetic wood layer being co-extruded onto the foam layer (column 3, lines 5-10). This reads on the synthetic wood layer being chemically bonded to the foamed polymer layer. Stucky teaches the synthetic wood layer comprising a polymeric resin filled with wood fiber to provide a wood-like appearance (column 3, line 9). Stucky discloses the foam layer

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comprising 35 to 75 wt % PVC or polypropylene, 25 to 65 wt % wood fiber, 1.5 parts of blowing agent per 100 parts of PVC, 7 parts of acrylic processing aid per 100 parts of PVC and a small amounts of lubricant and stabilizer (column 4, lines 8-10, tables I, II). Stucky discloses the use of lubricant and stabilizer but does not specifically disclose the amounts of lubricant and stabilizer being incorporated in the foamed composition. However, discovering the optimum or workable ranges for the amounts of lubricant and stabilizer involves only routine skill in the art. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricant and stabilizer having the amounts instantly claimed motivated by the desire to facilitate the processing and thermally stabilize the composite material. This is in line with *In re Aller*, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

Stucky discloses the synthetic wood layer comprising a polymeric resin, wood filler and additives but does not specifically disclose the amount of individual component in the synthetic wood layer. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the suitable amount of each individual component. Deaner teaches a polymer/wood composite material for use in door and window sills and sashes comprising 50 wt% PVC, 50 wt% wood fiber (table I) wherein the PVC resin comprising 100 parts of PVC, 1.5 parts calcium stearate stabilizer, 2 parts of lubricant, 7.5 parts acrylic resin process aid within the claimed ranges (column 8, lines 35-45). Deaner teaches that the composition provides the

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polymer/wood composite material having a high modulus, high compressive strength, low thermal transmission and improved resistance to insect attack and rot (column 2, lines 15-25), which is important to the invention of Stucky and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the synthetic wood layer having the composition as taught in Deaner motivated by the desire to provide the composite material having a high modulus, high compressive strength, low thermal transmission and improved resistance to insect attack and rot.

Stucky discloses the composite material comprising an inorganic filler (column 4, lines 61-63) but does not specifically disclose the amount of the inorganic filler being used in the composition. However, discovering the optimum or workable range for the amount of an inorganic filler involves only routine skill in the art. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the inorganic filler having an amount instantly claimed motivated by the desire to improve the strength of the composite material. This is in line with In re Aller, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

3. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stucky et al (US 6,344,268) in view of Deaner et al (US 5,486,553) as applied to claim 1, as evidenced by Zehner et al (US 5,866,264). Stucky does not specifically disclose the foam layer being secured to the synthetic wood layer by an adhesive or a

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mechanical fastening device. Zehner is relied on as evidence that teaches an adhesive or a mechanical lock feature being used to enhance the interlock of the two materials (column 3, lines 65 et seq.), which is important to the invention of Stucky and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an adhesive or a mechanical lock feature to bind the foam layer to the synthetic wood layer motivated by the desire to improve the bonding between the two layers.

4. Claims 14, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722). Woodhams teaches a rod having a foam core surrounded by a solid skin of the same composite compound (figure 4, column 11, lines 10-13). This reads on the solid skin layer being chemically bonded to the foam core. Woodhams discloses the circular polypropylene integral foam profile for use in window and door frames comprising 50 wt % polypropylene, and 50 wt % sawdust, 8 parts wax per 100 parts of polypropylene (example 1). Woodhams does not specifically disclose the amount of the lubricant within the claimed range. However, discovering the optimum or workable range for the amount of the lubricant being use in the composition involves only routine skill in the art. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricant having an amount instantly claimed motivated by the desire to facilitate the processing of the composite material. This is in line with In re Aller, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

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5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722) as applied to claim 14 above, as evidenced by Zehner et al (US 5,866,264). Woodhams does not specifically disclose the foam layer being secured to the solid skin layer by an adhesive or a mechanical fastening device. Zehner is relied on as evidence that teaches an adhesive or a mechanical lock feature being used to enhance the interlock of the two materials (column 3, lines 65 et seq.), which is important to the invention of Woodhams and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an adhesive or a mechanical lock feature to bind the foam layer to the skin layer motivated by the desire to improve the bonding between the two layers.
6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722) as applied to claim 14 above, in view of Godavarti et al (US 6,265,037). Woodhams does not specifically disclose the inclusion of inorganic filler in the composite material. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the use of the inorganic filler in the composite material. Godavarti teaches a composite material made of a polypropylene polymer and a wood fiber, having the same composition as Woodhams. Godavarti teaches the composite material comprising 0.1 to 10 wt% of compatilizing agent including both organic and inorganic fillers to achieve improvements in the physical, mechanical and thermal properties of the composite material, which is important to the invention of Woodhams, thus further suggesting the modification (column 11,

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lines 1-5). Therefore, in an absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the inorganic filler within the range instantly claimed, motivated by the desire to achieve improvements in the physical, mechanical and thermal properties of the composite material.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 14, 15, 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of U.S. Patent No. 6,579,605 in view of Woodhams (US 5,474,722). Claims 4 and 5 of U.S. Patent No. 6,579,605 disclose every and each element of the claimed subject matter except the presence of lubricant in the synthetic wood layer. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the presence of lubricant in the synthetic wood layer. Woodhams discloses the circular polypropylene integral foam profile for use in window and door frames comprising 50

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wt % polypropylene, and 50 wt % sawdust, 8 parts wax per 100 parts of polypropylene (example 1). Woodhams does not specifically disclose the amount of the lubricant within the claimed range. However, discovering the optimum or workable range for the amount of the lubricant being use in the composition involves only routine skill in the art. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricant having an amount instantly claimed motivated by the desire to facilitate the processing of the composite material. This is in line with In re Aller, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

Response to Arguments

9. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.
10. The art rejections over Stucky and Hendrickson have been overcome by the present arguments (pages 4 and 5 of the amendment received on 04/21/2003).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax

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phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

Hai Vo